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Filing date: **09/04/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209617
Party	Plaintiff Xikar, Inc.
Correspondence Address	GINNIE C DERUSSEAU ERICKSON KERNELL ET AL 8900 STATE LINE RD STE 500 LEAWOOD, KS 66206 UNITED STATES ekdkdocket@kcpatentlaw.com, ginnied@kcpatentlaw.com, mjiles@kcpatentlaw.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Ginnie C. Derusseau
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Signature	/Ginnie C. Derusseau/
Date	09/04/2014
Attachments	20140904 Motion to Dismiss or Strike.pdf(172242 bytes) 20140904 Brief for Motion to Dismiss or Strike.pdf(295489 bytes) 20140904 Ex. A - Settlement Proposal.pdf(964579 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 85/652,496
filed June 14, 2012 for CICAR

Xikar, Inc.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91209617
)	
Debra Wiseberg)	
d/b/a Bram Warren Company,)	
)	
Applicant.)	
_____)	

**OPPOSER’S MOTION TO DISMISS OR, IN THE ALTERNATIVE,
MOTION TO STRIKE APPLICANT’S AMENDED COUNTERCLAIMS**

Pursuant to Fed. R. Civ. P. 12(b)(6) and Trademark Rule of Practice 2.127, Opposer, Xikar, Inc. (“Xikar”), hereby moves the Board for dismissal of Applicant Debra Wiseberg’s (“Ms. Wiseberg” or “Bram Warren Company” or “BWC”) amended counterclaims. In the alternative, Xikar requests that the amended counterclaims be stricken pursuant to Fed. R. Civ. P. 12(f) as they violate the Board’s instruction in its July 18, 2014 decision on summary judgment that BWC must only assert valid grounds for cancellation. In support of this motion, Xikar incorporates by reference, its Brief in Support and accompanying exhibit, filed and served concurrently herewith.

WHEREFORE, Xikar respectfully requests dismissal of BWC’s amended counterclaims or, in the alternative, Xikar requests that the amended counterclaims be stricken. Furthermore, Xikar requests the Board require BWC to obtain counsel, BWC to participate in mediation, or any other remedy deemed appropriate to help resolve this proceeding.

Additionally, Xikar requests the suspension of the Opposition and the Cancellation proceedings, pursuant to Trademark Rule of Practice 2.127(d) pending resolution of this Motion.

Respectfully submitted,

Dated: 9-4-14

By Ginnie C. Derousseau

Ginnie C. Derousseau, Reg. #35,855

James J. Kernell, Reg. #42,720

Kyle D. Donnelly, Reg. #67,171

Arthur A. Chaykin

ERICKSON, KERNELL, DERUSSEAU
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8900 State Line Road, Suite 500

Leawood, KS 66206

Telephone: (913) 549-4700

Facsimile: (913) 549-4646

E-mail: ginnied@kcpatentlaw.com

Attorneys for Opposer
XIKAR, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S MOTION TO DISMISS OR, IN THE ALTERNATIVE, MOTION TO STRIKE APPLICANT'S AMENDED COUNTERCLAIMS has been served upon Debra Wiseberg d/b/a Bram Warren Company, 18100 S.W. 50 Street, Southwest Ranches, Florida 33331 by deposit in the United States Mail with first class postage thereon fully prepaid, this 4th day of September 2014.


Ginnie C. Derousseau

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 85/652,496
filed June 14, 2012 for CICAR

Xikar, Inc.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91209617
)	
Debra Wiseberg)	
d/b/a Bram Warren Company,)	
)	
Applicant.)	
_____)	

**OPPOSER’S BRIEF IN SUPPORT OF ITS MOTION TO DISMISS
OR, IN THE ALTERNATIVE, MOTION TO STRIKE
APPLICANT’S AMENDED COUNTERCLAIMS**

Opposer, Xikar, Inc. (“Xikar”), hereby files its brief in support of its motion to dismiss or strike Applicant Debra Wiseberg’s (“Ms. Wiseberg” or “Bram Warren Company” or “BWC”) amended counterclaims.

I. INTRODUCTION

BWC’s original counterclaim was based on several untenable and facially defective allegations, which resulted in the claim being stricken *sua sponte* by the Board. The allegations included bizarre arguments of genericness and deceptiveness with multiple irrelevant references to the Mayan culture mixed in. The Board granted BWC a reprieve to file an amended counterclaim asserting a valid ground for cancelling registration, if there is such a claim. BWC’s amended counterclaims are the subject of the present motion. The amended

counterclaims do not set forth any valid ground for cancelling Xikar's registration and they consist largely of the same frivolous arguments made in the original counterclaim.

As Xikar has noted on a number of occasions, and the Board referenced in its latest decision, BWC comprises a sole unrepresented individual who is struggling to interpret trademark law. BWC is not represented by counsel and this entire proceeding has suffered because of it. In its latest decision, the Board admonished BWC to obtain trademark counsel. However, it is clear from BWC's amended counterclaims that it has not taken the Board's advice. BWC's refusal to obtain counsel has led to increased costs to Xikar as a result of counsel having to spend time arguing meritless allegations. BWC's lack of counsel has also completely stymied settlement discussions. Xikar has reached out numerous times to discuss settling this case. Each time BWC has summarily dismissed Xikar's offers and refused to make a counteroffer. As an example, the latest attempt at a settlement negotiation is attached as Exhibit A. BWC's continued defiance is unfortunately bolstered by a significant misunderstanding of trademark law.

Xikar respectfully requests that the Board dismiss BWC's amended counterclaim in its entirety for failing to state a claim upon which relief can be granted. In the alternative, Xikar requests that the amended counterclaims be stricken as they violate the Board's latest instruction that BWC must only assert a valid ground for cancellation.

II. LEGAL STANDARDS

The Board may dismiss a claim (or counterclaim) for failing to state a claim upon which relief can be granted. Fed. R. Civ. P. 12(b)(6). Dismissal is proper "if it is clear that no relief could be granted under any set of facts that could be proved consistent with the allegations." *Hishon v. King & Spalding*, 467 U.S. 69, 73 (1984). All well-pleaded facts and the

reasonable inferences derived from the facts are viewed in the light most favorable to complainant. *Adv. Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc.*, 988 F.2d 1157, 1161 (Fed. Cir. 1993). To survive a motion to dismiss, a complaint must “state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007). Filing a motion to dismiss for failure to state a claim upon which relief can be granted tolls the time for filing an answer. *Hollowform, Inc. v. Delma Aeh*, 180 USPQ 284, 286 (TTAB 1973).

Upon motion, or upon its own initiative, the Board may strike an impermissible or insufficient claim from a pleading. *See* Fed. R. Civ. P. 12(f); TBMP § 506.01 (citing *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999) and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990)). Although motions to strike tend to be disfavored, they may be granted in appropriate cases. *See e.g. American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313 (TTAB 1992) (striking insufficient affirmative defenses).

III. ANALYSIS

a. BWC Has Improperly Added New Counterclaims¹

37 CFR § 2.106(b)(2)(i) states in part, “A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer.” All of BWC’s counterclaims are

¹ The title of BWC’s amended pleading suggests that there is only one amended counterclaim, however it is clear from the “Counterclaims for Cancellation” section heading and the individual headings for each claim that there are in fact several counterclaims.

compulsory because they attack the validity of Xikar's registration, and the grounds alleged for each counterclaim existed when BWC's answer was first filed.

It is clear from previous decisions by the Board that compulsory counterclaims not presented with the original answer cannot be asserted later in the proceeding. *See e.g. S & L Acq. Co.*, 9 USPQ2d 1221 (TTAB 1987). In the present matter, the Board gave BWC an opportunity to set forth valid grounds for cancelling the registration, but the amended counterclaims are still subject to § 2.106(b)(2)(i). If there was any question regarding the scope of the amended counterclaims, we need only look at the case cited by the Board in support of its decision to allow an amendment. *See* July 18, 2014 Decision on Summary Judgment, p. 8 (citing *Musical Directions v. McHugh*, 104 USPQ2d 1157 (TTAB 2012) (after the Board *sua sponte* struck all asserted claims, the Board allowed the opposer to refile amended versions *of the stricken claims*)).

In addition to claims of genericness and deceptive matter, BWC has added counterclaims of functionality, fraud, and misrepresentation as to source of goods. All of these counterclaims were available when BWC filed its answer. In *S & L Acq. Co.*, the Board denied applicant's motion to amend its answer because the elements of the new claim were available to the applicant when the answer was originally filed. 9 USPQ2d at 1224. Similarly, in our case, the elements of BWC's three new counterclaims were available to BWC at the time its answer was filed. They are doctrines that have been included in the trademark statutes for many years. Undoubtedly, BWC encountered the claims back when it initially read through the statutes to cherry pick its original counterclaims. Furthermore, none of the new counterclaims rely on facts that were unavailable at the beginning of this case.

In summary, the three new counterclaims asserted by BWC, namely functionality, fraud, and misrepresentation as to source of goods are facially improper and should be immediately rejected. They are compulsory counterclaims that could have and should have been raised when BWC first filed its answer to the opposition. The Rules of Practice in Trademark Cases specifically bar compulsory counterclaims from being asserted after an answer is filed. Nonetheless, Xikar will also address the deficiencies in each counterclaim in case the Board chooses not to reject them under § 2.106(b)(2)(i).

b. XIKAR is Not Generic

BWC continues to make the frivolous argument that XIKAR is somehow generic for cigar cutters due to an ancient Mayan word that translates loosely to cigar. The Board has unequivocally rejected this argument. *See* July 18, 2014 Decision on Summary Judgment, p. 5. In its amended counterclaim, BWC suggests that XIKAR is generic “because the registration is for ‘cigar cutters’ and the translation and meaning of ‘xikar’ is ‘cigar’; the genus of the Opposer's goods are cigar accessories and cigars.” Applicant’s Amended Counterclaim, ¶ 5. While not entirely clear, BWC seems suggest that XIKAR is generic for cigar cutters because XIKAR is somehow linked to the word cigar and cigars are the “genus” of Xikar’s goods. This theory is devoid of both fact and law.

XIKAR is a completely made-up word. It does not translate to or mean “cigar.” For some reason, BWC cannot accept this fact and continues to make the assertion without any evidence in support. Also, the Board has already stated that even if XIKAR was based on an ancient Mayan word meaning “cigar,” that does not make XIKAR generic for cigar cutters. *See* July 18, 2014 Decision on Summary Judgment, p. 4-5 (“Applicant’s theory that the word ‘sikar’ gave rise to the word ‘cigar’ and also served as inspiration for Opposer’s XIKAR mark does not

state a claim that XIKAR is generic for cigar cutters.”). BWC tries to circumvent the Board’s decision by suggesting that the word cigar is the “genus” of Xikar’s goods. By that rationale, the word cigar would be a generic term for any and all smoking accessories. That theory is not only absurd, it is also not the law.

c. XIKAR is Not Functional

BWC has again illustrated its misunderstanding of trademark law by suggesting that XIKAR is not entitled to trademark protection because it is functional. The amended counterclaims state that XIKAR “is for ‘cigar cutters’ which are made for and to be used with ‘cigars’ making the ‘Xikar’ trademark functional.” Applicant’s Amended Counterclaim, ¶ 6. The falsity of this statement is obvious. Just because a product being sold under a mark is functional does not make the mark itself functional. This is just another example of the frivolous claims being asserted by BWC. Had an attorney raised this claim, it would very likely result in sanctions due to its lack of relevance and frivolousness.

d. XIKAR Does not Comprise Deceptive Matter

BWC has reasserted deceptiveness based on an alleged connection between XIKAR and the Mayan culture. Basically, BWC attempts to use deceptiveness to continue its argument that XIKAR is somehow using the Mayan culture to violate trademark laws. The argument is so ludicrous that a rebuttal almost seems unnecessary. Nevertheless, Xikar must at least point out that BWC has not pled all of the elements for a claim of deceptiveness.

In its summary judgment decision, the Board set forth the elements that BWC would have to plead for a claim of deceptiveness. The elements are: (1) Opposer’s mark misdescribes the identified goods, (2) consumers would be likely to believe the

misrepresentation, and (3) the misrepresentation would materially affect potential purchasers' decision to purchase the product. *See* July 18, 2014 Decision on Summary Judgment, p. 5. BWC has not pled any of these elements. BWC has not shown how XIKAR, an entirely fabricated word, misdescribes Opposer's cigar cutters. Obviously, since misdescription has not been shown, neither have the second and third elements.

e. XIKAR Does not Misrepresent the Source of its Goods

As discussed above, XIKAR has improperly added a counterclaim for misrepresentation as to the source of goods. BWC has also failed to properly plead the counterclaim. "A pleading of misrepresentation of source must be supported by allegations of blatant misuse of the mark by respondent in a manner calculated to trade on the goodwill and reputation of petitioner." *Otto Intl., Inc. v. Otto Kern GMBH*, 83 USPQ2d 1861, 1863 (TTAB 2007). Stated another way, a "cancellation claim for misrepresentation under § 14(3) requires a pleading that registrant deliberately sought to pass off its goods as those of petitioner." J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 20:60 (4th ed. 2014).

Based on the allegations supporting the counterclaim, BWC is confused about what constitutes misrepresentation. The counterclaim states that "actions and statements made by the Opposer may cause confusion in consumers as to the source of the Opposer's goods." Applicant's Amended Counterclaim, ¶ 31. The counterclaim then references allegations that Xikar deceives consumers into believing that its goods "originate from the Mayans." *Id.* at ¶ 29. This is not what a misrepresentation claim is intended to address. Misrepresentation is reserved for instances when a registrant is misrepresenting that its goods are affiliated with the petitioner. That is clearly not the case here. Once again, BWC has utterly misinterpreted trademark law.

f. XIKAR Was not Obtained Fraudulently

As discussed above, XIKAR has improperly added its fraud counterclaim. Furthermore, BWC has included blatantly false and conclusory allegations in support of the counterclaim. The claim does not identify what specific actions were allegedly fraudulent. Instead, BWC broadly asserts that XIKAR was fraudulently obtained “based on an invalid 1) Application; 2) Statement of Use; 3) Declaration; 4) Assignment; 5) and Declaration of Use and Incontestability under Sections 8 & 15.” Applicant’s Amended Counterclaim, ¶ 36. Fed. R. Civ. P. 9(b) requires a party alleging fraud to “state with particularity the circumstances constituting fraud.” BWC has not done this.

In addition to pleading fraud with particularity, the following elements must be shown: (1) the false representation regarding a material fact; (2) the registrant's knowledge or belief that the representation is false; (3) the intention to induce action or refraining from action in reliance on the misrepresentation; (4) reasonable reliance on the misrepresentation; and (5) damages proximately resulting from such reliance. *See San Juan Products, Inc. v. San Juan Pools of Kansas, Inc.*, 849 F.2d 468, 473 (10th Cir. 1988); *McCarthy*, § 31:61.

Essentially, BWC is using its fraud counterclaim as a catch-all in case its other claims fail. It has gathered every possible negative allegation it can think of and grouped them under a counterclaim of fraud. This is evident by nearly every paragraph in the amended counterclaim document being incorporated into the fraud claim. This collection of disingenuous allegations is nothing more than a smear campaign that BWC hopes will look bad enough to keep its fraud claim from being dismissed.

Even with this wide variety of false allegations, BWC is unable to meet all of the elements listed above. For instance, at the least, none of the allegations suggest that the

Trademark Office reasonably relied on any alleged misrepresentations (fourth element), or that there was damage resulting from reliance (fifth element). Without these two elements, BWC's claim for fraud cannot stand.

IV. REQUESTED REMEDIES

In addition to dismissing or striking the counterclaims, Xikar requests additional remedies given the outrageous course of this proceeding. Xikar could move the Board to sanction BWC for its frivolous conduct pursuant to Fed. R. Civ. P. 11 but prefers to avoid tying up further resources of the Board and the parties.

As the Board is aware, BWC is not represented by an attorney. This has resulted in numerous baseless and frivolous counterclaims as well as protracted discovery issues. Xikar is convinced that if BWC had counsel, this matter would be settled. In fact, this proceeding would likely never have been filed. It would have settled without the need for an opposition proceeding. Xikar has reached out several times to discuss settlement and each time BWC has summarily rejected Xikar's proposal. *See, e.g.* Exhibit A.

In lieu of a motion for sanctions, and in addition to dismissing BWC's counterclaims, Xikar requests that the Board either require BWC to obtain counsel or participate in mediation held in Kansas City, Missouri, Xikar's place of business. Neither party is well served by an opposition proceeding that spends more time correcting misstatements of law than deciding the merits of the case.

V. CONCLUSION

For the foregoing reasons, Xikar respectfully request that the Board grant its Motion to Dismiss or, in the Alternative, Motion to Strike Applicant's Amended Counterclaims. Additionally, Xikar urges the Board to require BWC to obtain counsel, BWC to participate in mediation, or any other remedy deemed appropriate to help resolve this proceeding.

Respectfully submitted,

Dated: 9-4-14

By Ginnie C. Derusseau

Ginnie C. Derusseau, Reg. #35,855

James J. Kernell, Reg. #42,720

Kyle D. Donnelly, Reg. #67,171

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Telephone: (913) 549-4700

Facsimile: (913) 549-4646

E-mail: ginnied@kcpatentlaw.com

Attorneys for Opposer
XIKAR, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S BRIEF IN SUPPORT OF ITS MOTION TO DISMISS OR, IN THE ALTERNATIVE, MOTION TO STRIKE APPLICANT'S AMENDED COUNTERCLAIMS has been served upon Debra Wiseberg d/b/a Bram Warren Company, 18100 S.W. 50 Street, Southwest Ranches, Florida 33331 by deposit in the United States Mail with first class postage thereon fully prepaid, this 4th day of September 2014.


Ginie C. Derusse

EXHIBIT A
Page 1 of 8

From: [Ginnie Derusseau](#)
To: bramwarren@bramwarren.com
Cc: [Margaret Jiles](#)
Subject: RE: Trademark Opposition
Date: Thursday, August 07, 2014 1:26:46 PM

For Settlement Purposes Only

Debra:

My client would very much like to settle this matter without further time and expense. We believe we have a settlement proposal beneficial to both parties. The proposal allows you to obtain a federal registration without the risk of confusion between the marks in the marketplace.

The details are as follow:

1. You will file a proposed amendment to the identification of goods recited in your application to read "hand sculpted car cigar ashtrays" with the TTAB pursuant to Trademark Rule 2.133 and TBMP 605.03(b);
2. Xikar will consent to the amendment;
3. Xikar will file a request for a suspension of the proceedings pending the TTAB's acceptance of the amendment and settlement;
4. Within ten (10) days of acceptance of the amendment by the TTAB and with your consent, Xikar will withdraw the opposition to your application without prejudice pursuant to Rule 2.106(c), and allow your application to register;
5. You will agree not to expand your use of the mark CICAR beyond the goods recited in your registration and will not seek any additional registrations for CICAR;
6. You will agree not to challenge Xikar's use, registrations or applications for registration of the mark XIKAR;
7. Xikar will agree not to challenge your use or registration of the mark CICAR so long as the terms of the settlement are followed.

Please note that the proposed amendment to the description of goods is taken from your web-site and clarifies the distinction between our clients' products. If these terms are acceptable, I will draft a settlement agreement. I look forward to resolving this with you.

Regards,

Ginnie

Ginnie C. Derusseau
Erickson, Kernell, Derusseau & Kleypas LLC
913-549-4700
913-549-4646 (fax)
ginnied@kcpatentlaw.com <<mailto:ginnied@kcpatentlaw.com>>

EXHIBIT A
Page 2 of 8

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From: bramwarren@bramwarren.com [mailto:bramwarren@bramwarren.com]
Sent: Friday, August 01, 2014 11:24 AM
To: Ginnie Derusseau
Subject: RE: Trademark Opposition

Ginnie,

I tried to call you at your office as requested, but I was told you are not in today, so I have responded by email. Please send me a letter outlining the possible settlement offer that your client has in mind and I will respond accordingly.

Debra Wiseberg d/b/a
Bram Warren Company
18100 S.W. 50 Street
Southwest Ranches, FL 33331
Telephone: (954) 297-0329
Email: bramwarren@bramwarren.com

----- Original Message -----

Subject: Trademark Opposition
From: Ginnie Derusseau <ginnied@kcpatentlaw.com>
Date: Wed, July 30, 2014 2:11 pm
To: "bramwarren@bramwarren.com" <bramwarren@bramwarren.com>
Cc: Margaret Jiles <mjiles@kcpatentlaw.com>

#wmQuoteWrapper /* Font Definitions */ @font-face {font-family:Calibri; panose-1:2 15 5 2 2 2 4 3 2 4;} #wmQuoteWrapper /* Style Definitions */ p.MsoNormal, #wmQuoteWrapper li.MsoNormal, #wmQuoteWrapper div.MsoNormal {margin:0in; margin-bottom:.0001pt; font-size:11.0pt; font-family:"Calibri","sans-serif";} #wmQuoteWrapper a:link, #wmQuoteWrapper span.MsoHyperlink {mso-style-priority:99; color:blue; text-decoration:underline;} #wmQuoteWrapper a:visited, #wmQuoteWrapper span.MsoHyperlinkFollowed {mso-style-priority:99; color:purple; text-decoration:underline;} #wmQuoteWrapper span.EmailStyle17 {mso-style-type:personal-compose; font-family:"Calibri","sans-serif"; color:windowtext;} #wmQuoteWrapper .MsoChpDefault {mso-style-type:export-only; font-family:"Calibri","sans-serif";} #wmQuoteWrapper @page WordSection1 {size:8.5in 11.0in; margin:1.0in 1.0in 1.0in 1.0in;} #wmQuoteWrapper div.WordSection1 {page:WordSection1;}

Debra:

I would like to discuss the possibility of settling this matter. Please give me a call at your convenience.

Ginnie

Ginnie C. Derusseau
Erickson, Kernell, Derusseau & Kleypas LLC
913-549-4700
913-549-4646 (fax)
ginnied@kcpatentlaw.com <<mailto:ginnied@kcpatentlaw.com>>

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Via Regular Mail and Email

For Settlement Purposes Only - Without Prejudice - Federal Rules of Evidence Rule 408

August 19, 2014

Ginnie C. Derusseau
Erickson, Kernell, Derusseau & Kleypas, LLC
8900 State Line Road, Suite 500
Leawood, KS 66206
ginnied@kcpatentlaw.com

Re: Xikar, Inc. v. Debra Wiseberg
Opposition No. 91209617

Dear Ms. Derusseau,

This letter is written in response to your settlement proposal sent by email on August 7, 2014. You stated in your email that your "client would very much like to settle this matter without further time and expense" considering the settlement proposal offered I find that statement hard to believe. The amendment and restrictions you suggest are absurd and unacceptable. In addition, you propose that your client will withdraw its opposition without prejudice and at the same time you propose that I agree to not challenge your client's use, registrations, or applications of the mark "Xikar", which is unacceptable and one-sided.

If your client has a reasonable and fair settlement offer, then please forward such offer for my consideration, because the settlement proposal that you have offered is not acceptable.

Sincerely,



Debra Wiseberg
18100 S.W. 50 Street
Southwest Ranches, FL 33331
Telephone: (954) 297-0329
Email: bramwarren@bramwarren.com

From: [Ginnie Derusseau](#)
To: bramwarren@bramwarren.com
Cc: [Margaret Jiles](#)
Subject: RE: Trademark Opposition
Date: Wednesday, August 27, 2014 10:54:15 AM

For Settlement Purposes Only

Ms. Wiseberg:

Contrary to your assertion that my client's August 7 settlement offer is "absurd", it is very beneficial to you and is evenhanded.

As detailed in the August 7 proposal, just as the settlement would provide that you agree not to challenge Xikar's use and registrations, Xikar similarly would agree not to challenge your use and registration. That is even handed.

The settlement further provides for withdrawal of the opposition and allows you to obtain a registration for the goods in connection with which you actually use the mark. These are very beneficial terms for you.

As strongly recommended by the Trademark Trial and Appeal Board, please consult with an attorney that specializes in trademark law with regard to this settlement offer. I truly believe any such attorney would find this settlement proposal reasonable. At least, provide me with your counter-offer as that is standard procedure after a settlement offer is proposed.

Regards,

Ginnie Derusseau

Ginnie C. Derusseau
Erickson, Kernell, Derusseau & Kleypas LLC
913-549-4700
913-549-4646 (fax)
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From: Ginnie Derusseau
Sent: Thursday, August 07, 2014 1:27 PM
To: 'bramwarren@bramwarren.com'
Cc: Margaret Jiles
Subject: RE: Trademark Opposition

For Settlement Purposes Only

Debra:

My client would very much like to settle this matter without further time and expense. We believe we have a settlement proposal beneficial to both parties. The proposal allows you to obtain a federal registration without the risk of confusion between the marks in the marketplace.

The details are as follow:

1. You will file a proposed amendment to the identification of goods recited in your application to read "hand sculpted car cigar ashtrays" with the TTAB pursuant to Trademark Rule 2.133 and TBMP 605.03(b);
2. Xikar will consent to the amendment;
3. Xikar will file a request for a suspension of the proceedings pending the TTAB's acceptance of the amendment and settlement;
4. Within ten (10) days of acceptance of the amendment by the TTAB and with your consent, Xikar will withdraw the opposition to your application without prejudice pursuant to Rule 2.106(c), and allow your application to register;
5. You will agree not to expand your use of the mark CICAR beyond the goods recited in your registration and will not seek any additional registrations for CICAR;
6. You will agree not to challenge Xikar's use, registrations or applications for registration of the mark XIKAR;
7. Xikar will agree not to challenge your use or registration of the mark CICAR so long as the terms of the settlement are followed.

Please note that the proposed amendment to the description of goods is taken from your web-site and clarifies the distinction between our clients' products. If these terms are acceptable, I will draft a settlement agreement. I look forward to resolving this with you.

Regards,

Ginnie

Ginnie C. Derusseau
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913-549-4646 (fax)
ginnied@kcpatentlaw.com <<mailto:ginnied@kcpatentlaw.com>>

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From: bramwarren@bramwarren.com [<mailto:bramwarren@bramwarren.com>]
Sent: Friday, August 01, 2014 11:24 AM
To: Ginnie Derusseau
Subject: RE: Trademark Opposition

Ginnie,

I tried to call you at your office as requested, but I was told you are not in today, so I have responded by email. Please send me a letter outlining the possible settlement offer that your client has in mind and I will respond accordingly.

Debra Wiseberg d/b/a
Bram Warren Company
18100 S.W. 50 Street
Southwest Ranches, FL 33331
Telephone: (954) 297-0329
Email: bramwarren@bramwarren.com

----- Original Message -----

Subject: Trademark Opposition
From: Ginnie Derusseau <ginnied@kcpatentlaw.com>
Date: Wed, July 30, 2014 2:11 pm
To: "bramwarren@bramwarren.com" <bramwarren@bramwarren.com>
Cc: Margaret Jiles <mjiles@kcpatentlaw.com>

#wmQuoteWrapper /* Font Definitions */ @font-face {font-family:Calibri; panose-1:2 15 5 2 2 2 4 3 2 4;} #wmQuoteWrapper /* Style Definitions */ p.MsoNormal, #wmQuoteWrapper li.MsoNormal, #wmQuoteWrapper div.MsoNormal {margin:0in; margin-bottom:.0001pt; font-size:11.0pt; font-family:"Calibri","sans-serif";} #wmQuoteWrapper a:link, #wmQuoteWrapper span.MsoHyperlink {mso-style-priority:99; color:blue; text-decoration:underline;} #wmQuoteWrapper a:visited, #wmQuoteWrapper span.MsoHyperlinkFollowed {mso-style-priority:99; color:purple; text-decoration:underline;} #wmQuoteWrapper span.EmailStyle17 {mso-style-type:personal-compose; font-family:"Calibri","sans-serif"; color:windowtext;} #wmQuoteWrapper .MsoChpDefault {mso-style-type:export-only; font-family:"Calibri","sans-serif";} #wmQuoteWrapper @page WordSection1 {size:8.5in 11.0in; margin:1.0in 1.0in 1.0in 1.0in;} #wmQuoteWrapper div.WordSection1 {page:WordSection1;}

Debra:

I would like to discuss the possibility of settling this matter. Please give me a call at your convenience.

Ginnie

Ginnie C. Derusseau
Erickson, Kernell, Derusseau & Kleypas LLC
913-549-4700
913-549-4646 (fax)
ginnied@kcpatentlaw.com <<mailto:ginnied@kcpatentlaw.com>>

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